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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR R. FRANCIS and BRAD B. TOPOL

Appeal 2008-003894
Application 09/543,952
Technology Center 2100

Decided: March 15, 2010

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

INVENTION

Appellants' invention is directed to a system, apparatus and method for the transformation of Java Server Pages (JSPs) into formats for various pervasive computing (PvC) devices. (Spec. 1).

ILLUSTRATIVE CLAIM

1. A method of transforming an original Java Server Page (JSP) file into a pervasive computing (PvC) device specific JSP file, comprising:
 - receiving a request for the original JSP file at a server, wherein the request is sent from the PvC device, and wherein the original JSP file is stored on the server;
 - parsing the original JSP file for JSP tags;
 - masking the JSP tags;
 - converting non-masked tags in the original JSP file into PvC device specific format tags;
 - unmasking the JSP tags; and
 - storing a transformed JSP file containing the PvC device specific format tags and the JSP tags, wherein the parsing, masking, converting, unmasking and storing steps are performed by the server.

PRIOR ART

Hawkins	US 6,343,318 B1	Jan. 29, 2002
Ginter	US 5,892,900	Apr. 6, 1999
Judson	US 6,185,586 B1	Feb. 6, 2001

Ramaley	US 6,585,777 B1	July 1, 2003
Toyouchi	US 6,847,988 B2	Jan. 25, 2005

Jason Hunter, *ProQuest Information and Learning – Java Servlet Programming*, Pages 1-20, (1998)

THE REJECTIONS

1. The Examiner rejected claims 1, 6, 7, 8, 13, 14, 15, 20-22, 27, and 28 under 35 U.S.C. § 103(a) as unpatentable over the combination of Hawkins, Hunter, and Ginter.
2. The Examiner rejected claims 2, 3, 9, 10, 16, 17, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over the combination of Hawkins, Hunter, Ginter, and Judson.
3. The Examiner rejected claims 4, 5, 11, 12, 18, 19, 25, and 26 under 35 U.S.C. § 103(a) as unpatentable over the combination of Hawkins, Hunter, Ginter, and Ramaley.
4. The Examiner rejected claims 29-31 under 35 U.S.C. § 103(a) as unpatentable over the combination of Hawkins, Hunter, Ginter, and Toyouchi.

CONTENTIONS BY APPELLANTS

Appellants note, *inter alia*, that the excerpt of Ginter cited against the steps of masking and unmasking JSP tags “mentions that a validation tag is

masked by the site-specific key.” (App. Br. 16). However, Appellants make the following contentions:

“Ginter does not disclose or suggest that such a validation tag is later unmasked. In contrast, per the features of Claim 1, the JSP tag is unmasked so that the tag can be used to retrieve dynamic information for the JSP page. Additionally, the rejection admits that this feature is not disclosed or suggested by Hawkins or Hunter. Nor is this validation tag any type or form of a JSP tag. Claim 1 expressly recites that the tags that are masked and unmasked are JSP tags. Therefore, since none of the references relied on disclose or suggest the feature of “unmasking the JSP tags”, the combination of the references when considered as a whole does not teach or suggest all of the features of the claims. Accordingly, no *prima facie* case of obviousness has been shown against Claim 1.”

(*Id.*).

THE EXAMINER’S RESPONSE

The Examiner disagrees. The Examiner responds that “Ginter is relied upon to teach protecting certain file elements (validation tags), with a masking operation, during a file transformation process (i.e. encryption). Encryption inherently includes a second decryption process that unmasks the protected file elements.” (Ans. 12, ¶1).

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Under § 103, would the combination of Hawkins, Hunter, and Ginter have taught or suggested masking and unmasking Java Server Page (JSP)

tags so that only non-masked tags are converted, as claimed? (See independent claims 1, 8, 15, and 22).

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

FINDINGS OF FACT

1. Ginter teaches

UDEs 1200 are preferably encrypted using a site specific key once they are loaded into a site. This site-specific key masks a validation tag that may be derived from a cryptographically strong pseudo-random sequence by the SPE 503 and updated each time the record is written back to the secure database 610. This technique provides reasonable assurance that the UDE 1200 has not been tampered with nor substituted when it is requested by the system for the next use.

(Col. 150, ll. 34-42).

2. Hunter teaches

JSP [a Java Server Page] operates in many ways like server-side includes. The main difference is that instead of embedding a <SERVLET> tag in an HTML page, JSP embeds actual snippets of servlet code. It's an attempt by Sun to separate content from presentation, more

convenient than server-side includes for pages that have chunks of dynamic content intermingled with static content in several different places.
(Page 1 of 15; *see* § 2.6 “JavaServer Pages”).

3. Hunter teaches the use of JSP tags that enclose JSP expressions beginning with “`<%=`” and ending with “`%>`” and JSP directives beginning with “`<%@`” and ending with “`%>`”. (Pages 5 and 6 of 15).

ANALYSIS

Independent claims 1, 8, 15, and 22

We decide the question of whether the combination of Hawkins, Hunter, and Ginter would have taught or suggested masking and unmasking Java Server Page (JSP) tags so that only non-masked tags are converted within the meaning of Appellants’ independent claims 1, 8, 15, and 22.

After considering the evidence before us, and the respective arguments on both sides, we conclude that the Examiner’s proffered combination of Hawkins, Hunter, and Ginter would not have fairly rendered obvious Appellants’ claimed invention. In particular, we agree with the thrust of Appellants’ argument that even if Ginter’s mention of a validation tag that is masked by a site-specific key is *arguendo* found to suggest (in combination with Hunter) the masking of a JSP tag, Ginter does not teach that such a validation tag is later unmasked. (App. Br. 16, ¶2).

We begin our analysis by noting that the secondary Hunter reference teaches the use of Java Server Pages and JSP tags which are used to enclose JSP expressions and directives. (FF 2-3). We note that the Examiner looks to

the tertiary Ginter reference to teach the claimed masking of tags. (Ans. 6-7). While we agree that Ginter teaches masking a validation tag (FF 1), we particularly note that the Examiner fails to indicate in the rejection of claim 1 where Ginter (or any other reference) teaches or suggests the claimed unmasking of tags. (*Id.*). The Examiner attempts to address this deficiency in the “Response to Arguments” section of the Answer by stating that “Ginter is relied upon to teach protecting certain file elements (validation tags), with a masking operation, during a file transformation process (i.e. encryption). *Encryption inherently includes a second decryption process that unmasks the protected file elements.*” (Ans. 12, ¶1, emphasis added).

We note that Ginter teaches user data elements (UDE 1200, Fig. 24) that are encrypted using a site specific key that masks a validation tag. (FF 1). In contrast, Appellants claimed invention uses masked tags to distinguish between JSP tags and non-JSP tags¹ so that only the non-masked (non-JSP) tags are converted into PvC device specific format tags. (Independent claims 1, 8, 15, and 22).

In particular, we find Ginter’s validation tag (relied on by the Examiner) is not masked for the purpose of distinguishing between different types of tags so that only non-masked tags are converted, as claimed by Appellants. We also find Ginter’s site specific key is used to perform the encryption for the purpose of “provid[ing] reasonable assurance that the UDE 1200 has not been tampered with . . .” (FF 1, underline added).

Because Ginter’s validation tag performs a totally different function than Appellants’ claimed JSP tags, we do not find the Examiner’s reading of

¹ e.g., HTML tags, *see* Appellants’ Spec. 9, ll. 10-14.

Appellants' claimed "masking" and "unmasking" of (JSP) tags on Ginter's encryption and (purportedly inherent) decryption to be reasonable. (See Ans. 12, ¶1). Moreover, we agree with Appellants that Ginter does not teach or suggest that a validation tag is later unmasked. (App. Br. 16, ¶2).

Therefore, for the reasons discussed *supra*, we also find unpersuasive the Examiner's gap-filling reasoning that "it would have been obvious, to one of ordinary skill in the art . . . to combine the masking of tags as taught by Ginter with the transformation of files for pervasive computing devices as taught by Hawkins and Hunter in order to '*maintain the integrity, availability, and/or confidentiality of such information and processes related to such use*' (Ginter, column 1, lines 13-15)." (Ans. 7, ¶1). We find the Examiner has not sufficiently developed the record to lay a proper foundation that reasonably establishes why an artisan (having knowledge of Hawkins and Hunter) would need the *integrity, availability, and/or confidentiality*, as disclosed by Ginter. (Ginter, col. 1, ll. 13-15).

In the alternative, we also find the Examiner has not sufficiently developed the record to establish that Appellants' claimed implementation of masked and unmasked JSP tags so that only non-masked tags are converted is merely "the predictable use of prior art elements according to their established functions." *KSR* at 417.

Accordingly, the Examiner has not established, and we do not find, that Ginter overcomes the admitted deficiencies of Hawkins and Hunter. (See Ans. 6: "Hawkins and Hunter fail to disclose the masking and unmasking of specific tags in the conversion process.").

While we need not reach any further issues to decide this appeal, we nevertheless also express our agreement with Appellants' reasoning (App. Br. 18-19) regarding the Examiner's statement in the Answer that certain dependent claims are "rejected for fully incorporating the deficiencies of their base claims." (Ans. 7). Because each rejected dependent claim recites additional limitations (not addressed by the Examiner), we agree with Appellants that this form of rejection fails to establish a *prima facie* case.

Accordingly, we reverse the Examiner's first-stated obviousness rejection of independent claims 1, 8, 15, and 22. Because we have reversed the Examiner's rejection of each independent claim on appeal, we also reverse the Examiner's obviousness rejections of each dependent claim on appeal.

CONCLUSION

The Examiner's proffered combination of Hawkins, Hunter, and Ginter does not teach nor fairly suggest masking and unmasking Java Server Page (JSP) tags so that only non-masked tags are converted within the meaning of Appellants' independent claims 1, 8, 15, and 22.

ORDER

We reverse the Examiner's decision rejecting claims 1-31 under 35 U.S.C. § 103(a).

REVERSED

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